

REMARKS

Reconsideration of this application is respectfully requested.

Initially, the Applicant would like to thank the Examiner for the indication that claims 22 and 31 are allowed.

However, the Examiner withdraws the previous grounds of rejection in favor of new rejections. Specifically, the Examiner rejects claims 36-38 under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,064,428 to Cope et al., (hereinafter "Cope"). Furthermore, the Examiner rejects claims 37 and 39 under 35 U.S.C. § 103(a) as being unpatentable over Cope in view of U.S. Patent No. 6,264,664 to Avellanet (hereinafter "Avellanet").

In response, Applicants respectfully traverse the Examiner's rejections under 35 U.S.C. §§ 102(b) and 103(a) for at least the reasons set forth below.

The present invention as recited in claims 36-39 relate to a medical retrieval instrument having at least one filament in a distal end portion for holding an object. The filament is fixed at one end to the distal end of a sheath of the instrument with a fixing member.

In assembly processes of the prior art for medical retrieval instruments, precise mounting of the filament at a distal end portion of the instrument was difficult because the filament often slips on the distal end surface. Such a disadvantage of the prior art is discussed throughout the specification of the present application and in particular at page 2, lines 5-10 of the present specification which states:

Regardless of the above-mentioned problem, a medical retrieval instrument of the Japanese Utility Model Laid-Open Publication No. 1-172813 has a filament basket, one end of which is only held by a ring-like holding tube and fixed to a sheath. Such a mounting configuration is unstable, since one end portion of the filament basket easily slips on the outer surface. Therefore, it takes

more time to mount one end portion of the filament basket at a predetermined position and in a predetermined direction (Emphasis Added).

Regarding this problem, the present invention as recited in claims 36-39 proposes providing a hole or a groove on the sheath or fixing member in a predetermined position and direction for accommodating and fixing the one end of the filament in such predetermined position and direction as regulated by the hole or groove. As a result of such a configuration, fixing the filament to the instrument in the assembly process becomes easy and the efficiency thereof is increased, as compared to the medical retrieval instruments of the prior art.

Claim 36 recites that a groove is provided in a predetermined position and direction for accommodating and fixing the one end of the at least one filament in the predetermined position and direction regulated by the groove. Claim 38 recites that a hole as the accommodation part is provided in a predetermined position and direction for accommodating and fixing the one end of the at least one filament in the predetermined position and direction regulated by the hole.

In stark contrast, Cope discloses a medical retrieval basket having metal alloy wires (104-106). A stainless steel tube (115-120) is crimped on an end of each wire and each of the crimped tubes is then fixed to a flat surface (121-126) of a tube (114) by spot welds or solder (column 4, lines 4-8 and Fig. 2). Thus, each of the crimped tubes on the wires must be positioned on a corresponding flat recess prior to fixing thereto. Since the recesses are flat, there is no guide on the surfaces thereof to orient the crimped sleeves at a precise position and direction. Therefore, the medical retrieval instrument of Cope suffers from the same disadvantages as those of the prior art discussed above and in the present specification, namely, the crimped sleeves may slip during spot welding or soldering and make the assembly difficult and also may cause the wires to be oriented in a different direction and position that that

intended. Cope does not contemplate the problem overcome by the present invention as recited in claims 36-39 nor does the medical retrieval instrument disclosed in Cope provide a solution thereto.

Turning now to the language of the claims, Cope does not disclose or suggest a groove or a hole as are recited in claims 36 and 38. The crimped tube of Cope may form a hole around a wire, but since such a hole is made in conformity with each filament, the hole has no “predetermined position and direction,” its position and direction can only be the same as the position and direction of the wire attached thereto. There is simply no disclosure or suggestion in Cope of a groove or hole **provided in a predetermined position and direction** for accommodating and fixing one end of a filament in the **predetermined position and direction regulated by the groove or hole.**

With regard to the rejection of claims 36-38 under 35 U.S.C. § 102(b), a medical retrieval instrument having the features discussed above and as recited in independent claims 36 and 38, is nowhere disclosed in Cope. Since it has been decided that “anticipation requires the presence in a single prior art reference, disclosure of each and every element of the claimed invention, arranged as in the claim,”¹ independent claims 36 and 38 are not anticipated by Cope. Accordingly, independent claims 36 and 38 patentably distinguish over Cope and are allowable. Claim 37 being dependent upon claim 36, is thus at least allowable therewith. Consequently, the Examiner is respectfully requested to withdraw the rejection of claims 36-38 under 35 U.S.C. § 102(b).

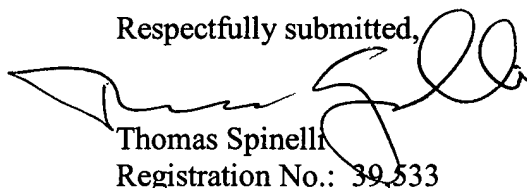
¹ Lindeman Maschinenfabrik GMBH v. American Hoist and Derrick Company, 730 F.2d 1452, 1458; 221 U.S.P.Q. 481, 485 (Fed. Cir., 1984).

With regard to claims 37 and 39, since independent claims 36 and 38 patentably distinguish over the prior art and are allowable, claims 37 and 39 are at least allowable therewith because they depend from an allowable base claim.

In other words, independent claims 36 and 38 are not rendered obvious by the cited references because neither the Cope patent nor the Avellanet patent, whether taken alone or in combination, teach or suggest a medical retrieval instrument having the features discussed above. Accordingly, claims 36 and 38 patentably distinguish over the prior art and are allowable. Claims 37 and 39, being dependent upon claims 36 and 38, are thus allowable therewith. Consequently, the Examiner is respectfully requested to withdraw the rejection of claims 37 and 39 under 35 U.S.C. § 103(a).

In view of the above, it is respectfully submitted that this application is in condition for allowance. Accordingly, it is respectfully requested that this application be allowed and a Notice of Allowance issued. If the Examiner believes that a telephone conference with Applicant's attorneys would be advantageous to the disposition of this case, the Examiner is requested to telephone the undersigned.

Respectfully submitted,



Thomas Spinelli
Registration No.: 39,533

Scully, Scott, Murphy & Presser
400 Garden City Plaza, Suite 300
Garden City, New York 11530
(516) 742-4343
TS:dg